

## **REMARKS**

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

By the foregoing amendment, claim 13 has been amended, claim 11 has been canceled, and new claims 34 and 35 have been added. No new matter has been added. Claims 10, 21, and 30 were previously canceled. Thus, claims 1-9, 12-20, and 22-35 are currently pending in the present application and subject to examination.

The Examiner rejected claims 1-9, 11-14, 16-20, 24, and 25, and 27-29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,634,064 to Warnock et al. ("Warnock") in view of U.S. Patent No. 5,239,665 to Tsuchiya et al ("Tsuchiya"). The Examiner rejected claims 15, 22, 23, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Warnock in view of Tsuchiya and further in view of what would have been obvious to one of ordinary skill in the art. It is noted that claim 13 has been amended and claim 12 has been canceled. To the extent that the rejections remain applicable to the claims currently pending, the Applicant hereby traverses the rejection, as follows.

### **I. Claim 13**

The Applicant submits that the cited art does not disclose or suggest a system for accessing electronic books including at least a catalog printer connected to a file server for storing books, wherein the catalog printer is capable of printing information about the electronic books stored on the file server, wherein the electronic books have encoded text, and wherein the catalog printer cannot access the encoded text, as recited in amended claim 13.

Among other things, this allows a file server to provide and print limited information regarding available electronic books while limiting access to the actual electronic book.

The Office Action points to Warnock as teaching a printer. However, the printers discussed in Warnock specifically print electronic documents. Warnock does not disclose or suggest a catalog printer that prints information about electronic books and cannot access the encoded text of electronic books, as recited in claim 13.

For at least this reason, the Applicant submits that claim 13 is allowable over the cited art.

## **II. Claims 34-35**

The Applicant submits that the cited art does not disclose or suggest a system for accessing electronic books including at least an electronic viewer adapted for connection to the controller, which viewer stores electronic book data in encoded form and displays electronic books, and wherein the electronic viewer includes a secure microprocessor configured to decode the encoded electronic book data only at the time of display, as recited in claim 34.

For at least this reason, the Applicant submits that claim 34 is allowable over the cited art. As claim 34 is allowable, the Applicant submits that claim 35, which depends from allowable claim 34, is therefore also allowable for at least the above noted reason and for the additional subject matter recited therein.

## **III. Claims 1-9, 12, 14-20, and 22-33**

The Applicant's invention as now set forth in claim 1 is directed to a system for accessing electronic books including a file server that stores electronic books, a

controller connected to the file server for controlling access to electronic books on the file server, and a viewer adapted for connection to the controller, which viewer stores and displays electronic books, wherein the viewer is limited to receiving a determined number of electronic books at a time from the controller.

Tsuchiya teaches an electronic book and an automatic vending machine. However, the Applicant submits that Tsuchiya does not disclose or suggest the system including a viewer limited to receiving a determined number of electronic books at a time from a controller, as claimed in amended claim 1. Warnock fails to cure this deficiency in Tsuchiya.

For at least this reason, the Applicant submits that claim 1 is allowable over the cited art. The Applicant submits that claims 16 and 24 are likewise allowable. As claims 1, 16, and 24 are allowable, the Applicant submits that claims 2-9, 12, 14-15, 17-20, 22-23, 25, 27-29, and 31-33, which each depend from allowable claims 1, 16, and 24, are, therefore, also allowable for at least the above noted reasons and for the additional subject matter recited therein.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The

PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at page 9. This is an insufficient showing of motivation.

#### **IV. 35 U.S.C. § 112**

In the Office Action mailed October 2, 2006, the Examiner rejected claims 1-9, 11-20, and 22-29, and 31-33 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. The Applicant respectfully submits that these claims are supported at least by page 24, lines 14-15 and originally filed claims 21 and 29 of the present application. The controller is taught as monitoring the data being transferred, so that the controller is limited to downloading to only authorized viewers and is limited to downloading a chosen number of books at a time. In addition, the software for controlling the system is located primarily in the controller. (See page 24, lines 4-5). The Applicant submits that it would not require undue experimentation for one of ordinary skill in the software art to limit the downloading of electronic books to a chosen number of books, using the hardware and software shown and described in the

specification at least in Figure 15 and pages 23-25. Therefore, the Applicant submits that claims 1-9, 11-20, and 22-29, and 31-33 comply with the written description requirement and respectfully request the withdrawal of the rejection.

### **CONCLUSION**

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, with reference to Attorney Docket No. 026880-00021.

Respectfully submitted,

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